



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,633	08/01/2003	Gunter Lewentz	071308.0458	2771

31625 7590 07/07/2005

BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

EXAMINER

GORMAN, DARREN W

ART UNIT PAPER NUMBER

3752

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/632,633	Applicant(s) LEWENTZ ET AL.	
	Examiner Darren W. Gorman	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,9,10,12,13,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 3,6,8,11,14 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 5, 7, 9, 10, 12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Keiczek, USPN 4,202,500.

Regarding claims 7, 9 and 10, Keiczek shows an embodiment of a fuel injector (see Figure 1) comprising a nozzle body (3) having a valve needle assembly (9, 13) with a stop portion (no #) being displaceably disposed therein, a nozzle holder (4) with a pressure pin (no #) being displaceably disposed therein, a disk-shaped stop element (6) between the nozzle body and the nozzle holder, the stop element having a fuel inlet bore therein, wherein the nozzle body and the nozzle holder are axially tensioned against one another, wherein first and second sealing surfaces of the stop element each incorporate cutouts (annuli 20), the cutouts being implemented evenly opposite one another in the sealing surfaces, the cutouts being deepened by a predetermined axial depth in the first and second sealing surfaces, and the cutouts appearing to have a circular shape (see again Figure 1, cutouts 20 referred to as “annuli”). Regarding the recitation “for the purpose of increasing the contact pressure of the sealing surfaces” as recited in claim 7, the cutouts shown by Keiczek, regardless of intention, would inherently increase the contact pressure of the sealing surfaces because of the reduced surface areas of the contact faces.

Art Unit: 3752

Regarding method claims 1, 4, 5, 12, 15 and 16, the apparatus shown by Keiczek, as discussed above with regard to apparatus claims 7, 9 and 10, when manufactured/assembled, anticipates the recited method steps. Regarding the recitation “producing at least one cutout in the two sealing surfaces in a single manufacturing operation”, it is clear that the at least one cutout would be produced in a single manufacturing operation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keiczek.

Keiczek teaches all of the claimed method steps as set forth in claims 1 and 12 (see above paragraph 2), however Keiczek is silent as to the process or processes for creating the at least one cutout in the stop element.

Since Applicant has not properly traversed the Examiner’s assertion of Official Notice, as set forth in paragraph 9 of the Office Action mailed February 8, 2005, the Examiner is now officially and clearly indicating that such a process step is admitted to be common or well-known in the art, and is therefore taken to be admitted prior art. See MPEP 2144.03 (C)

Allowable Subject Matter

5. Claims 3, 6, 11, 14 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments, see page 6 of the response filed June 8, 2005, with respect to the objection to the drawings under 37 CFR 1.83(a) have been fully considered and are persuasive. The objection to the drawings has been withdrawn.

7. Applicant's arguments, see page 7 of the response filed June 8, 2005 with respect to the rejection of claims 1, 7 and 12 under 35 U.S.C. 102(b) as being anticipated by Keiczek, USPN 4,202,500 have been fully considered but they are not persuasive.

It appears that Applicant believes the amendments made to claims 1, 7 and 12 clearly distinguish a "fuel inlet bore" from the "at least one cutout" as recited. Although, as amended, these elements are now distinguished from each other, this does not preclude that the two elements may still be associated with each other. Applicant's attention is now directed to the embodiment shown in Figure 1 of Keiczek which clearly shows a fuel inlet bore passing completely through stop element (6), with identical cutouts (annuli 20) located in an upstream end and a downstream end of the segment of the fuel inlet bore located in the stop element. It is therefore the Examiner's position that although the fuel inlet bore is associated with the cutouts

Art Unit: 3752

in Figure 1 of Keiczek, the fuel inlet bore and the cutouts shown by Keiczek are features that are distinguishable from each other, and therefore claims 1, 4, 5, 7, 9, 10, 12, 15 and 16 remain anticipated by at least the embodiment shown in Figure 1 of Keiczek.

8. Applicant's arguments, see pages 7 and 8 of the response filed June 8, 2005 with respect to the rejection of claims 2 and 13 under 35 U.S.C. 103(a) as being unpatentable over Keiczek have been fully considered but they are not persuasive.

Applicant argues that the cited prior art does not render the claimed embodiment of the invention obvious, however Applicant does not specifically point out the supposed errors in the Examiner's rejection under 35 U.S.C. 103(a). Applicant merely recites the three-pronged test for establishing a *prima facie* case of obviousness, but does not expressly discuss how the Examiner has erred in rejecting claims 2 and 13 under 35 U.S.C. 103(a). The Examiner's rejection under 35 U.S.C. 103(a) as set forth in the Office Action mailed February 8, 2005, states that the Examiner has taken Official Notice that it is common and well known to create bores in fuel injector components using at least "drilling" techniques. Since Applicant has not properly traversed the Official Notice taken by the Examiner in the Office Action mailed February 8, 2005, the Examiner has officially and clearly indicated that such a process step is admitted to be common or well known in the art. (See paragraph 4 above, and MPEP 2144.03 (C))

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Gorman whose telephone number is 571-272-4901. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on 571-272-4901. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Darren W Gorman
Examiner
Art Unit 3752

DWG 6/29/05
DWG
June 29, 2005


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

7/5/05